

## REMARKS

Claims 1-4 and 12-18 are pending in the application. Claims 1-5, 7 and 8 were rejected under 35 U.S.C. § 112, second paragraph, as described in paragraph six of the Office Action. Claims 1-5 were rejected under 35 U.S.C. § 102(b), as described in paragraph nine of the Office Action. Claims 6-8 were rejected under 35 U.S.C. § 103, as described in paragraph thirteen of the Office Action.

The specification has been amended to place the application in better U.S. form. Attached hereto is a substitute specification and a marked-up version thereof indicating the amendments made to the specification. It is submitted that the substitute specification includes no new matter.

Applicants affirm the election of Group I discussed in paragraph two of the Office Action. It is submitted that newly added claims 12-18 should be examined with Group I.

It is respectfully submitted that the outstanding rejections of claims 5-8 are moot, as the claims have been canceled.

Claims 1-4 have been amended to place the claims in compliance with 35 U.S.C. § 112, second paragraph. Specifically, claim 1 as amended more clearly recites a measuring apparatus for use with a biosensor. The measuring apparatus of amended claim 1 comprises a measuring unit. Further, claims 2-4 have been amended to further limit the measuring unit recited in independent claim 1.

In light of the above discussion, Applicants respectfully request that the outstanding rejection of claims 1-4 under 35 U.S.C. § 112, second paragraph be withdrawn.

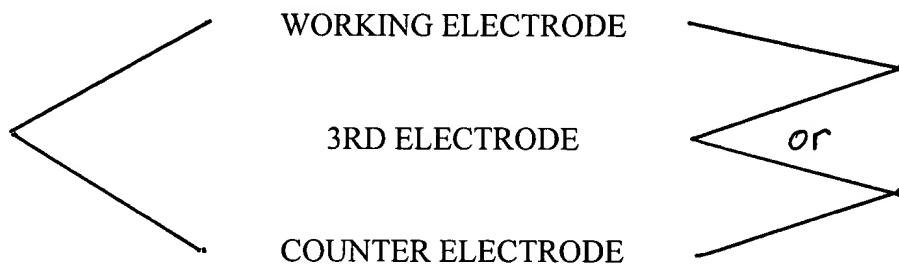
Claims 1-4 and 12-18 are patentable over the prior art of record for the following reasons.

A biosensor for use with the present invention includes a reaction layer which reacts with a substance to be measured in a sample solution. The reaction layer is on a working electrode, a counter electrode, and a third electrode which are provided on an insulating substrate, so as to bridge the respective electrodes.

In accordance with the present invention, first, contents of a substance to be measured in a sample solution are measured from a current value (produced by a reaction between the substance to be measured and the reaction layer) between the working electrode and the counter electrode of the biosensor. Second, in accordance with the present invention, the type of the sample solution is

judged based on an oxidation current value obtained between the third electrode and the counter electrode or between the third electrode and the working electrode. These two features are illustrated in Fig. A below and are recited in each of independent claims 1 and 12 as described further below.

Fig. A



Independent claim 1 recites:

...a measuring unit operable to measure contents of the substance to be measured from a current value which is produced by a reaction between the substance to be measured and the reaction layer, which reaction is obtained **between the working electrode and the counter electrode**, and to judge the type of the sample solution on the basis of an oxidation current value obtained **between the third electrode and the counter electrode or between the third electrode and the working electrode**.

Independent claim 12 recites:

...measuring contents of the substance to be measured from a current value which is produced by a reaction between the substance to be measured and the reaction layer, which reaction is obtained **between the working electrode and the counter electrode**, and

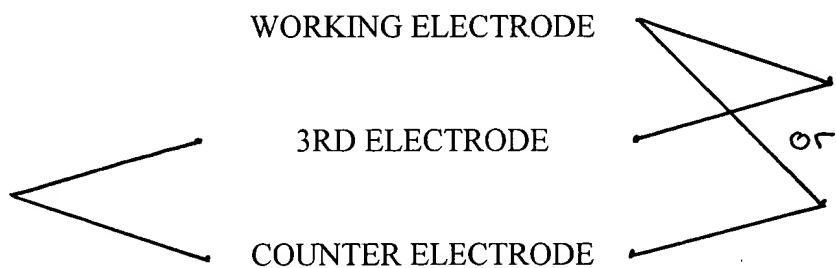
judging the type of the sample solution on the basis of an oxidation current value obtained **between the third electrode and the counter electrode or between the third electrode and the working electrode**.

Neither Ikeda nor Saurer discloses or suggests the above-identified limitations.

Ikeda discloses, for example as illustrated in Fig. 7, a biosensor B having a working electrode 5, a counter electrode 8 and third electrode 7. Ikeda additionally discloses a measuring device A, as illustrated in Fig. 7 and Fig. 8, for use with biosensor B. More specifically, Figs. 7 and 8 illustrate the two disclosed methods of measuring using biosensor B.

As discussed in column 14, lines 8-32 of Ikeda, the first example of measuring with respect to Fig. 7 includes measuring a current value between third electrode 7 and counter electrode 8. Then, after a predetermined period, the method with respect to Fig. 7 detects a current between working electrode 5 and counter electrode 8 or between working electrode 5 and third electrode 7. Fig. B below illustrates the measuring method discussed with respect to Fig. 7 of Ikeda.

Fig. B

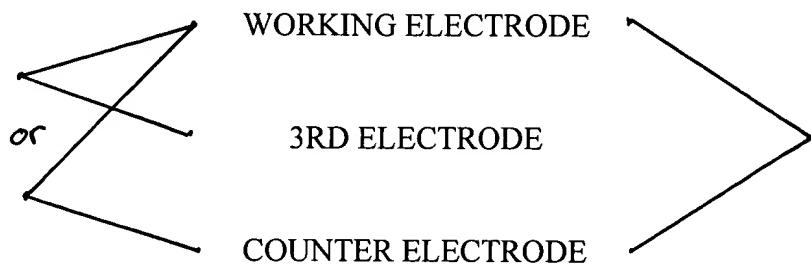


Clearly, by comparing that which is recited in independent claims 1 and 12 with that which is disclosed in Ikeda (with respect to the first embodiment for measuring using the biosensor as discussed above), Ikeda fails to disclose or suggest measuring contents of a substance to be measured from a current value obtained between the working electrode and the counter electrode. On the contrary, as illustrated in Fig. B above, and discussed in the reference, Ikeda discloses measuring current value between the third electrode and the counter electrode.

Fig. 8 of Ikeda illustrates the other method for measuring using the biosensor B. As disclosed in column 14, lines 40-57 of the reference, the second measuring embodiment includes a first step

of measuring the current value between working electrode 5 and counter electrode 8 or working electrode 5 and third electrode 7. The second embodiment as illustrated in Fig. 8 then, after a predetermined period of time, measures a current applied between working electrode 5 and counter electrode 8. Fig. C below illustrates the second method of measuring using the biosensor as illustrated in Fig. 8 of Ikeda.

Fig. C



Clearly, by comparing that which is recited in independent claims 1 and 12 with the embodiment disclosed in Fig. 8 of Ikeda, the embodiment fails to disclose or suggest judging a type of the sample solution on the basis of an oxidation current value obtained between the third electrode and the counter electrode or between the third electrode and the working electrode.

Furthermore, there is no suggestion in Ikeda that the two distinct methods of measuring that correspond to Figs. 7 and 8 can be combined. Additionally, because of the differences between that which is recited in claims 1 and 12 discussed above and the explicit disclosure in Ikeda, one of ordinary skill in the art at the time of the invention would not have been motivated to combine the two distinct embodiments disclosed with respect to Figs. 7 and 8 in Ikeda to arrive at the invention as recited in independent claims 1 and 12.

As anticipation under 35 U.S.C. § 102 requires that each and every element of the claim be disclosed in a prior art reference, *Akzo N.V. v. U.S. Int'l Trade Commission*, 808 F.2d 1471 (Fed. Cir. 1986), based on the foregoing, it is clear that Ikeda does not anticipate claims 1 and 12.

Moreover, in light of the differences between independent claims 1 and 12 and the disclosure in Ikeda, one of ordinary skill in the art at the time of the invention would not have been motivated to modify the teachings in Ikeda to arrive at the invention as recited in independent claims 1 and 12.

Consequently, claims 1 and 12, and dependent claims 3-4 and 13-18, are novel over Ikeda within the meaning of 35 U.S.C. § 102.

Furthermore, Saurer fails to disclose or suggest the shortcomings of Ikeda such that a combination of the teachings of Ikeda in view of Saurer would disclose or suggest that which is recited in independent claims 1 and 12.

As discussed in paragraph thirteen of the Office Action, Saurer is relied upon for teaching a specific composition of an electrode. However, Saurer fails to disclose or suggest a measuring unit as recited in independent claim 1 or measuring contents as recited in independent claim 12. Because neither Ikeda nor Saurer discloses or suggests a measuring unit or measuring contents as required in independent claims 1 and 12, respectively, a combination of the teachings of Ikeda and Saurer would additionally fail to disclose or suggest that which is recited in independent claims 1 and 12.

In light of the above discussion, it is respectfully submitted that independent claims 1 and 12, and therefore dependent claims 2-4 and 13-18, are patentable over the prior art of record.

Having fully and completely responded to the Office Action, Applicants submit that all of the claims are now in condition for allowance, an indication of which is respectfully solicited.

If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

Respectfully submitted,

Hiroyuki TOKUNAGA et al.

By:

  
Thomas D. Robbins  
Registration No. 43,369  
Attorney for Applicants

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TDR/kes  
Washington, D.C. 20006-1021  
Telephone (202) 721-8200  
Facsimile (202) 721-8250  
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